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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,898	06/28/2000	Jay S. Walker	99-112	6292

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EXAMINER	
DURAN, ARTHUR D	
ART UNIT	**PAPER NUMBER**
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/604,898	WALKER ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *291-316* is/are pending in the application.

4a) Of the above claim(s) *300* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *291-299 and 301-316* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *300* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 291-299 and 301-316 have been examined.

Response to Amendment

2. The Amendment filed on 2/20/2007 is sufficient to overcome the prior rejection. A new rejection has been made.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/20/2007 has been entered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 291-299 and 301-316 drawn to providing unlock codes to reveal a locked outcome, classified in class 705.

II. Claims 300 drawn to, after an outcome is indicated, receiving payment for an unlock code, providing a payment to an intermediary device in exchange for unlock codes, classified in class 705.

Inventions I and II are based on different sets of Independent claims. Group I involves providing unlock codes to reveal a locked outcome. Group II involves , after an outcome is indicated, receiving payment for an unlock code, providing a payment to an intermediary device in exchange for unlock codes.

Because these inventions are distinct for the reasons given above and the search required for Group I is different than the search required for Groups II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michael Downs at (203)461-7292 on 2/28/2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 291-299 and 301-316. Affirmation of this election must be made by applicant in replying to this Office action. Claim 300 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 291, 293-299 and 301, 309, 310, 314 are rejected under 35 U.S.C. 102(e) as being anticipated by Leason (6,251,017).

Claims 295, 291:

Claim 295: Leason discloses a method comprising:

obtaining a plurality of unlock codes, each unlock code being associated with an identifier that identifies a respective lottery outcome (col 12, lines 5-15; Figures 7-10);

determining that a user has satisfied a qualifying action that is associated with a retailer (col 12, lines 5-15, making the purchase);

receiving, by a device of the retailer from a device of a user, an identifier that identifies a lottery outcome that is locked (Figures 7-10);

determining an unlock code of the plurality of purchased unlock codes based on the received identifier that identifies the lottery outcome that is locked (Figures 7-10); and

providing the determined unlock code to the user (col 12, lines 5-15; Figures 7 and 9).

Also, Leason discloses the user purchasing a plurality of unlock codes (col 14, lines 30-35; Figures 1, 2, 7, 9).

Claim 291: Leason discloses a method comprising:

generating a plurality of locked outcomes (column 6, Table A; column 8, Table B; Figures 8 and 10);

generating, for each of the plurality of locked outcomes, a respective unlock code capable of unlocking the locked outcome (column 6, Table A; column 8, Table B; Figures 7-10);

transmitting at least one of the plurality of locked outcomes to a device of a user (Figures 8 and 10);

transmitting at least one of the plurality of unlock codes to a merchant, in which the user is not the same as the merchant (col 12, lines 5-15); and

receiving, from the user, an indication of at least one of the at least one unlock codes transmitted to the merchant (Figures 7-10).

Also, in regards to claims 291 and 295, please see the citations (col 9, lines 20-36 and col 10, lines 10- 60). Notice in these citations (col 9, lines 20-36 and col 10, lines 10- 60) and in the above citations (Figures 7-10; Tables A and B; col 12, lines 5-15) that the locked outcome information is kept in the Tables A and B. And, the locked outcome is presented via the GUI/Internet/Website in Figures 8 and 10. And, that the identifiers 706 (Figure 7), 906 (Figure 9), 1002 (Figure 10) identify the specific outcome/lottery/prize that is locked. And, the user receives the unlock code via the receipt/game card of Figures 7 and 9 (items 702 and 908). And, the user presents the unlock code to Figures 8 and 10 in order to unlock the locked outcome.

Claim 293: Leason discloses the method of claim 291, further comprising:

selling the at least one of the plurality of locked outcomes to the user (Abstract, 'Game Cards'; col 14, lines 30-35; Figures 6, 8, 10).

Claim 294: Leason discloses the method of claim 291, further comprising:

receiving an indication that at least one of the at least one locked outcomes transmitted to the device of the user has been unlocked (col 1, lines 26-40; Figures 8, 10).

Claim 296: Leason discloses the method of claim 295, in which determining that the user has satisfied the qualifying action comprises:

determining that the user visited an establishment of the retailer (col 2, lines 5-15).

Claim 297: Leason discloses the method of claim 295, in which determining that the user has satisfied the qualifying action comprises:

determining that the user purchased a product from the retailer (col 2, lines 55-61; Figure 9).

Claim 298: Leason discloses the method of claim 295, in which determining that the user has satisfied the qualifying action comprises:

receiving from the user an amount for a purchase that is not less than a predetermined amount (col 2, lines 55-61; Figure 9; where the purchase price of the item is the predetermined amount).

Claim 299: Leason discloses the method of claim 295, in which the device of the retailer comprises a point-of-sale terminal (col 11, lines 1-10).

Claim 301, 314: Leason discloses the method of claim 295, in which each unlock code of the plurality of purchased unlock codes is associated with a respective qualifying action that is based on an external event (col 2, lines 30-45; col 13, lines 15-20).

Claim 309: Leason discloses the method of claim 291, in which at least one of the at least one locked outcome transmitted to the device of the user is associated with a respective qualifying action in which the user is required to perceive predetermined content (col 13, lines 6-15).

Claim 310: Leason discloses the method of claim 291, in which at least one of the at least one locked outcome transmitted to the device of the user is associated with a respective qualifying action in which the user is required to view an advertisement (col 13, lines 6-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 292, 302, 315 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leason (6,251,017).

Claim 292: Leason discloses the above. Leason further discloses the merchant obtaining a plurality of unlock codes, each unlock code being associated with an identifier that identifies a respective lottery outcome (col 12, lines 5-15; Figures 7-10).

Leason does not explicitly disclose selling the at least one of the plurality of unlock codes to the merchant.

However, Leason discloses the user purchasing a plurality of unlock codes (col 14, lines 30-35; Figures 1, 2, 7, 9).

And, Leason discloses a processing center (col 1, lines 35-40; col 4, lines 60-67) and also franchises (col 1, lines 10-55; col 4, lines 60-67).

And, MPEP 2144.04.VI discloses that reversal, duplication, or rearrangement of parts is an obvious modification.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Leason's store's, franchises, movie theater's, theaters, etc can pay for the game cards/receipts/validation codes that get provided/sold/award to users. One would have been motivated to do this in order to cover the costs of participating in or operating the promotions system.

Also, since the user can be charged for the game cards/receipts/validation codes, it is also obvious that the retailer store/franchisor can also be charged. Retailers/franchisors sell products

at a retail price which they received at a wholesale price. Or, since the retailer charges the user, it is obvious that the processing center can charge the retailer.

Claims 302, 315: Leason discloses the above. Leason discloses that the awards can be tied to an external event.

Leason does not explicitly disclose that the external event is a sports game. However, Leason discloses the user going to theater in order to have a chance at receiving the awards (col 13, lines 15-20). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a sporting event as what the user can attend to receive the awards. One would have been motivated to do this in order to provide a wider range of venues/events/merchants who can participate and also to better provide venues/events/merchants of interest to the user.

6. Claims 303, 316 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leason (6,251,017) in view of Klayh (20030050831).

Claims 303, 316: Leason discloses the above.

Leason does not explicitly disclose that at least one of the at least one locked outcome transmitted to the device of the user is associated with a respective qualifying action, in which satisfaction of the qualifying action is determinable based on information ascertained from at least one of the following types of sensors: a retinal scanner, a heart monitor, a skin conductivity sensor, or a breath analyzer.

However, Leason discloses the user being identified (col 1, lines 40-55).

And, Klayh discloses a coupon/award system and a variety of sensors, including voice and eye, for identifying the user ([21]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Klayh's further user identification to Leason's user identification. One would have been motivated to do this in order to better identify the user.

7. Claim 304-307, 311-312 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leason (6,251,017) in view of Goldhaber (5,794,210).

Claims 304-307, 311-312:

Leason discloses the above. Leason further disclsoes the user viewing advertising (col 13, lines 6-20) and the user receiving awards/compensation for desired behavior/qualifying actions (see rejection above).

Leason does not explicitly disclose that the qualifying action is a survey, release private Information, to pass an accuracy test, whether the user answers similar questions consistently, required to achieve a predetermined performance level of a game, the user is required to achieve a predetermined performance level of a test of skill.

However, Goldhaber discloses receiving compensation/awards after the user is tested/questioned/surveyed/provides answers/is presented a game concerning content seen (col 11, lines 30-45; col 47-61). Golhdaber further discloses compensating for providing private information (col 11, lines 30-45; col 7, lines 60-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's providing compensation for ad awareness

demonstration to Leason's providing compensation when the user sees ads. One would have been motivated to do this in order to better assure that the user pays attention to the ad content.

8. Claims 308, 313 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leason (6,251,017) in view of Hiroshi (JP05101236A).

Leason discloses the above. Leason further disclsoes the device of the retailer comprises a point-of-sale terminal (col 11, lines 1-10). Leason further discloses the user utilizing a telephone for communications (col 13, lines 45-60).

Leason does not explicitly disclose a respective qualifying action in which the user is required to stand in line at a checkout counter or on hold for a predetermined period of time.

However, Hiroshi disclose a user receiving compensation/ a coupon for a respective qualifying action in which the user is required to stand in line at a checkout counter or on hold for a predetermined period of time (Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hiroshi's awarding a user forced to be in line to Leason's utilization of retailer POS and telephone communications. One would have been motivated to do this in order to better attract and keep users/buyers who have been forced to wait in line.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

For example, claim 291 can be read/interpreted from viewpoint of a central controller. And, Claim 295 can be interpreted/read from viewpoint of merchant. However, the claims do not specify who or what performs many of the actions of the claims. Therefore, the claims are open to a broad interpretation as to who or what performs the different steps of the claims.

Also, Examiner notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacobv, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

Examiner further notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is

being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Stoughton, 'Facing the Crowds';

b) Mothwurf (20050033642):

"[0013] In order to satisfy the above objects there is provided, in accordance with a first aspect of the invention, a method of promoting a product or a brand in a retail store comprising the steps of analyzing data determined at a point of sale relating to purchases by a customer, e.g. data from a bar-code scanner, to determine whether a customer has purchased a particular product or brand or has purchased products equaling or exceeding a predetermined value and, if this is the case, entitling the customer to participate in a prize/bonus ticket game configured as a game of chance, conducting a game of chance based on a predetermined win table having a specified number of predetermined winning numbers each associated with a bonus or prize and a further number of no win stops, i.e. numbers which are not winning numbers, and in the case of a win, issuing to the customer a lottery ticket which is a winning ticket associated with the product or product range.

[0014] The invention is thus based on the concept that the promotion of a particular product or brand of products can be made more exciting for the customer and more effective because of enhanced customer interest if the customer is entitled, on purchasing a product or brand, to participate in a game of chance which gives the opportunity for the customer to win a prize, with the validation of prizes taking place via a type of lottery ticket".

c) Eggleston (6061660)(Fig. 11; Fig. 12; and below):

"(88) Referring to FIG. 11, at the step 384 the HTTP server 188 of the host

computer 18 also initializes an application program that builds the underlying code for the incentive program. The application program may be programmed in a language for building incentive programs, such as C++. The application program inserts algorithms and generates code to create an incentive program satisfying the parameters entered by the sponsor. The code is a series of statements, such as C++ statements, each statement reflecting the implementation of one of the incentive program parameters defined by the sponsor. For example, a sweepstakes incentive program would include, as a step in the generated code, the generation of a random number, as well as the selection of a winner based on the random number. Once the incentive program is complete, the sponsor may pay for the incentive program by electronic funds transfer, credit card, or the like. Once the payment is confirmed, a file containing the code for the incentive program is transmitted, in the step 388, to the sponsor for downloading on the sponsor's site, whether by electronic mail, an HTTP link, or similar conventional transmission. As with the prepackaged incentive programs bought by the sponsor, the incentive program must be capable of generating a signal indicating that a consumer has won. The "win" signal calls an application program that updates the consumer database 200 to reflect that the consumer has won the prize associated with the incentive program and the application program updates the sponsor database 202 to reflect that the prize associated with the incentive program has been won by the customer. An HTML page is generated for the individual consumer indicating whether a win or loss has occurred and, in the case of a win, identifying the prize and fulfillment option."

d) Grippo (6017032):

"(20) Other means of acquiring tickets for use in playing the present lottery game may be provided, as well. For example, an advertiser, business, or the like may establish a relationship with the operator of the present lottery game in which players may purchase tickets using some collateral other than money, such as purchase receipts, product packaging or labeling (e.g., food wrappers), etc., in accordance with the arrangement between the establishment and the game operator. The game operator collects the appropriate non-monetary collateral from the bettors or players and presents it to the advertising or business establishment, whereupon the establishment reimburses the game operator for the equivalent amount of funds required to purchase the tickets provided for the non-monetary collateral".

e) Katz (5365575) discloses autocancel features:

"(55) The lottery ticket LT on its reverse side is provided with a bar code BC

defining a number corresponding to the unique identification number UN which would allow the retailer or the lottery system to verify instant winners when the lottery tickets are redeemed and automatically cancel related information on the data stored in the memory".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
2/28/2007